

## **REMARKS/ARGUMENTS**

### **a. Telephone Interview with Examiner**

Applicants thank the Examiner for the time to discuss the subject Advisory Action with Applicants' attorney Daniel Nesbitt on March 30, 2009, during which Applicants noted that all claim rejections raised in the Final Action mailed January 9, 2009 were either overcome or the claims canceled.

Applicants pointed out that while the wording of Claim 3 was amended in the response on March 9, 2009, the substance of Claim 3 was not amended. This can be confirmed by comparing amended Claim 3 (amended on March 9, 2009) with Claim 1 and Claim 3 pending prior to the amendment.

### **b. Applicants request a return of the application to prosecution, or an allowance**

In the final action mailed January 9, 2009, the following rejections of claims appeared:

- 1) Claims 1-3 and 11, anticipated by Mattson et al.
- 2) Claims 1, 2 and 11, anticipated by Young.
- 3) Claims 5-8 and 13-18, obvious over Mattson et al.
- 4) Claims 4, 9, 12 and 19-20, obvious over Mattson et al and Janghorbani.

With cancellation of Claims 1 and 2, independent Claim 3 was only rejected as anticipated over Mattson et al, and independent Claim 5 was only rejected as obvious in view of Mattson et al. Applicants assert that the rejections of Claims 3 and 5 over Mattson et al were traversed convincingly. All other remaining claims depend from Claim 3 or Claim 5.

Consequently, all claim rejections in the final rejection were either traversed, or rendered moot by cancellation of a claim, and no claim amendment was made by Applicants which would have required a new search or would have raised a new issue requiring a new rejection.

In the Advisory Action, the Examiner indicates that the claim amendments would not be entered because they raise new issues. That is clearly not the case. Applicants' claim amendments consisted of cancellation of claims only (Claims 1 and 2), with any remaining claims depending from the two canceled claims either rewritten into independent form (Claim 3) or their dependency changed (Claims 4 and 11).

Also in the Advisory Action, the Examiner states that the amendment to rewrite Claim 3 as an independent claim necessitates a new rejection under 35 USC 112, second paragraph, since it is not clear how much of the marker is in the composition compared to the recited percentages of the dietary fat, protein and carbohydrate. Since the substance of Claim 3 had not changed, this rejection against Claim 3 could have, and therefore ought to have, been made at the time of the Final Rejection on January 9, 2009, and is raised for the first time in the Advisory Action without basis.

Likewise, in the Advisory Action, the Examiner states that the amendment to rewrite Claim 3 as an independent claim necessitates a new rejection under 35 USC 103(a) over Mattson et al, due to the particular limitations in claim 3 concerning the amounts of dietary fat, protein and carbohydrate in the test composition. Again, since the substance of Claim 3 had not changed, this rejection against Claim 3 could have, and should have, been made at the time of the Final Rejection on January 9, 2009, and is raised for the first time in the Advisory Action without basis. MPEP 707.07 provides that, before a final rejection is in order, the references should be fully applied.

Applicants point out that Mattson et al identifies no particular advantage or benefit of using a sucrose polyester having a behenic acid chain length. Mattson et al discloses a large number of sucrose polyesters, of a widely varied chain length and type, most of which if substituted into the test composition of Mattson et al would not provide Applicants' claimed composition in Claim 3. Mattson et al states that their preferred alcohol fatty acid esters have fatty acids containing from 14 to 18 carbon atoms (see col 4 lines 23-27), which is outside the scope of Applicants' claims.

**c. Applicants request entry of the claim amendments file March 9, 2009**

In the absence of a return of the application to prosecution, or an allowance, Applicants request that the Examiner reconsider the denial of entry of the claim amendments filed March 9, 2009, which would place the claims into better condition for appeal, since the cancellation of Claims 1 and 2 would significantly reduce the issues that might be taken up on appeal. There is no clear basis for denying the amendments that amount to the cancellation of rejected claims.

**d. Some claims determined allowable**

If the Examiner determines that some claims are allowable while other claims are not or may require further examination, Applicants request that the Examiner telephone Applicants' attorney to effect any claim cancellation that would result in an allowance.

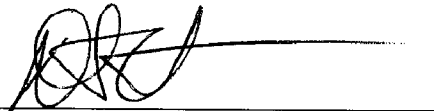
**Conclusion**

Applicants respectfully request a return of the application to prosecution to allow Applicant to address the new rejections raised by the Examiner, or an allowance. If the Examiner, despite Applicants position, decides not to either return the application to prosecution or to issue an allowance, then Applicants respectfully request that the Examiner enter the claim amendments filed March 9, 2009, which would place the claims into better condition for appeal. Also if some claims are allowable while other claims are not, please contact Applicants' attorney to effect any claim cancellation that would result in an allowance.

Respectfully submitted,

For: Ronald James JANDACEK et al

By



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